

1 Katherine D. Prescott (SBN 215496)
2 prescott@fr.com
3 Mike Sobolev (SBN 285184)
4 sobolev@fr.com
5 FISH & RICHARDSON P.C.
6 500 Arguello Street, Suite 500
7 Redwood City, California 94063
8 Telephone: (650) 839-5070
9 Facsimile: (650) 839-5071

10 David M. Hoffman (Admitted *Pro Hac Vice*)
11 hoffman@fr.com
12 FISH & RICHARDSON P.C.
13 111 Congress Avenue, Suite 810
14 Austin, Texas 78701
15 Telephone: (512) 472-5070
16 Facsimile: (512) 320-8925

17 Aamir A. Kazi (Admitted *Pro Hac Vice*)
18 kazi@fr.com
19 FISH & RICHARDSON P.C.
20 1180 Peachtree Street, N.E., 21st Floor
21 Atlanta, GA 30309
22 Telephone: (404) 892-5005
23 Facsimile: (404) 893-5002

24 Attorneys for Defendant
25 NVIDIA CORPORATION

26 Ryan E. Hatch (SBN 235577)
27 ryan@ryanehatch.com
28 LAW OFFICE OF RYAN E. HATCH, PC
13323 Washington Blvd., Suite 100
Los Angeles, CA 90066
Telephone: (310) 279-5076
Facsimile: (310) 693-5328

29 Attorneys for Plaintiff
30 VISUAL EFFECT INNOVATIONS, LLC

31 UNITED STATES DISTRICT COURT
32
33 NORTHERN DISTRICT OF CALIFORNIA
34
35 (SAN FRANCISCO DIVISION)

36 VISUAL EFFECT INNOVATIONS, LLC,

37 Case No. 3:17-cv-03187-VC

38 Plaintiff,

39 **JOINT CLAIM CONSTRUCTION AND**
40 **PREHEARING STATEMENT**

41 v.
42 NVIDIA CORPORATION,

43 DATE: January 23, 2019
44 TIME: 10:00 a.m.
45 JUDGE: Vince Chhabria

46 Defendant.

47

48

49

50

51

52

53

1 In accordance with Patent Local Rule 4-3, Plaintiff Visual Effect Innovations, LLC (“VEI”)
 2 and Defendant NVIDIA Corporation (“NVIDIA”) submit the following Joint Claim Construction
 3 and Prehearing Statement.

4 I. AGREED UPON TERMS

5 #	Term/Phrase/Claim(s)	Agreed
6 1.	“An electrically controlled spectacle for viewing a video, comprising” ‘304 Patent, claims 1, 9 ‘235 Patent, claim 1	The preamble is limiting
10 2.	“optoelectronic material” ‘304 Patent, claim 4 ‘235 Patent, claim 5	material that changes the transmission of light in response to a difference in electronic potential

13 II. DISPUTED TERMS

14 The parties’ constructions are set forth in the table below.

15 #	Term/Phrase/Claim(s)	NVIDIA	VEI
16 1.	“control the state of the each of the lenses independently” ‘304 Patent, claims 1, 9	Cause each lens to take a multiplicity of different levels of darkness independently ‘304 Specification: 8:23-10:40 15:35-44 16:45-17:30 20:63-21:39 30:17-29 Fig. 1-4 Fig. 9 Prosecution History: ‘495 Application File History, 2012-11-14 Applicant Arguments/Remarks Made in Amendment at 4-15. ‘495 Application File History, 2012-08-30	Cause each lens to take a dark or light level according to separate electronic signals. ‘304 Patent, 14:29-45; 15:35-44; 16:31-17:2; Fig. 3; Fig. 4; Definition of “Independent”; ‘304 Patent File History, May 30, 2014 Amendment at 6-9; claims 1-10; all evidence cited for the similar ‘235 Patent term, below; all evidence cited by NVIDIA.

#	Term/Phrase/Claim(s)	NVIDIA	VEI
		<p>Applicant Arguments/Remarks Made in Amendment at 3-11. '495 Application File History, 2012-03-22</p> <p>Applicant Arguments/Remarks Made in Amendment at 2-8. '495 Application File History, 2011-07-11</p> <p>Applicant Arguments/Remarks Made in Amendment at 3-8. '348 Patent File History – 2009-04-30</p> <p>Applicant Arguments/Remarks Made in Amendment at 12-14.</p>	
2.	"control the state of the each of the lenses independently" '235 Patent, claim 1	<p>Cause each lens to take a multiplicity of different levels of darkness independently</p> <p><u>'235 Specification:</u> 12:34-13:7 19:43-52 20:52-21:37 25:1-44 34:23-35 Fig. 1-4 Fig. 9</p> <p><u>Prosecution History:</u> '495 Application File History, 2012-11-14</p> <p>Applicant Arguments/Remarks Made in Amendment at 4-15. '495 Application File History, 2012-08-30</p> <p>Applicant Arguments/Remarks Made in Amendment at 3-11. '495 Application File History, 2012-03-22</p> <p>Applicant Arguments/Remarks Made in Amendment at 2-8.</p>	<p>Cause each lens to take an opacity level according to separate electronic signals.</p> <p>'235 Patent, 18:39-55; 19:43-52; Figs. 3 and 4; 20:38-21:37; Definition of "Independent"; '304 Patent File History, May 30, 2014 Amendment at 6-9; claims 1-16; all evidence cited for the similar '304 Patent term, above; all evidence cited by NVIDIA.</p>

#	Term/Phrase/Claim(s)	NVIDIA	VEI
		<p>'495 Application File History, 2011-07-11 Applicant Arguments/Remarks Made in Amendment at 3-8.</p> <p>'348 Patent File History – 2009-04-30 Applicant Arguments/Remarks Made in Amendment at 12-14.</p>	
3.	"a storage adapted to: store one or more image frames" '444 Patent, claim 26	<p>Indefinite</p> <p>'444 Specification: 10:18-43 10:58-11:37 11:42-57 11:58-12:13</p>	<p>Not Indefinite (the claim is not a mere catalog of elements).</p> <p>'444 Patent, Figs. 3-4, 11-14, 16-17, and 18-29; and column / line numbers 4:30-57, 6:46-12:21, 12:34-58, 12:65-13:9, 13:18-54, 14:53-15:3, 22:21-34, 23:8-26:3, 29:42-31:37, 33:56-38:34, 38:38-42:67, 43:6-45:36, 46:23-47:24, 47:39-54, 47:57-48:17, 48:24-50:57.</p>
4.	"processor adapted to . . ." including each of the functional limitations of the "processor." '444 Patent, claim 26	<p>This term is indefinite under 112(6).</p> <p>Function:</p> <ul style="list-style-type: none"> • obtain a first image frame from a first video stream; • generate a modified image frame by performing at least one of expanding the first image frame, shrinking the first image frame, removing a portion of the first image frame, stitching together the first image frame with a second image frame, inserting a selected image into the first image frame, and reshaping the first 	<p>Not Indefinite</p> <p>The term is not subject to 112(6) because it is not in means-plus-function format, and (2) it recites structure in the body of the claim in the form of a processor, and alternatively steps of an algorithm.</p> <p>In the alternative, to the extent the claim term is found to be subject to 112(6), corresponding structure for the functions recited in the claim (obtain a first image frame from a first video stream; generate a modified image frame by performing at least one of expanding the first image frame, shrinking the first</p>

#	Term/Phrase/Claim(s)	NVIDIA	VEI
		<p>image frame, wherein the modified image frame is different from the first image frame;</p> <ul style="list-style-type: none"> • generate a bridge frame, wherein the bridge frame is a solid color, wherein the bridge frame is different from the first image frame and different from the modified image frame; • display the modified image frame; and • display the bridge frame. <p>Structure: There is no structure disclosed in the specification for performing these functions.</p> <p><u>'444 Specification:</u></p> <p>5:42-58 6:64-12:13 41:48-42:6 44:50-62 45:60-46:61</p> <p><u>Expert:</u> Dr. Donald Alpert will opine that the term “processor” does not connote sufficient structure to one of ordinary skill in the art to perform the claimed functions, and that the specification of the ’444 patent provides only a functional description of the claim terms and that these limitations of the ’444 patent are therefore indefinite.</p>	<p>image frame, removing a portion of the first image frame, stitching together the first image frame with a second image frame, inserting a selected image into the first image frame, and reshaping the first image frame, wherein the modified image frame is different from the first image frame; generate a bridge frame, wherein the bridge frame is a solid color, wherein the bridge frame is different from the first image frame and different from the modified image frame; display the modified image frame; and display the bridge frame) is recited in the body of the specification, also in the form of a processor, and alternatively steps of an algorithm.</p> <p>‘444 Patent, Figs. 3-4, 11-14, 16-17, and 18-29; and column / line numbers 4:30-57, 6:46-12:21, 12:34-58, 12:65-13:9, 13:18-54, 14:53-15:3, 22:21-34, 23:8-26:3, 29:42-31:37, 33:56-38:34, 38:38-42:67, 43:6-45:36, 46:23-47:24, 47:39-54, 47:57-48:17, 48:24-50:57.</p> <p>Declaration of Dr. Trevor Smedley; all evidence cited by NVIDIA.</p>

1 **III. TEN TERMS WHOSE CONSTRUCTION WILL BE MOST SIGNIFICANT
2 TO THE RESOLUTION OF THE CASE**

3 The parties have worked to reduce the number of disputed terms to four terms, and thus,
4 identify all of the disputed terms above as the most significant terms for the resolution of the case.

5 **IV. ANTICIPATED LENGTH OF TIME NECESSARY FOR THE CLAIM
6 CONSTRUCTION HEARING**

7 Pursuant to this Court's August 23, 2017 Order and Standing Order for Patent Cases, the
8 tutorial is set for January 16, 2019 at 9:30 a.m., with the claim construction hearing to be held on
9 January 23, 2019 at 10:00 a.m. thereafter. [D.I. 69.] The parties anticipate that the claim
construction hearing will take no more than 3 hours.

10 **V. WITNESS TESTIMONY**

11 The parties do not anticipate calling any expert witnesses at the claim construction hearing.

12 VEI and NVIDIA anticipate having their experts present at the hearing to answer any
13 questions that the Court may have regarding the subject matter of their testimony.

14 **VI. FACTUAL FINDINGS**

15 VEI's position: One potential factual finding related to the parties' claim construction
16 disputes is whether a general purpose processor could be used to perform the functions of claim 26
17 of the '444 Patent.

18 NVIDIA's position: None.

19
20 Dated: December 5, 2017

FISH & RICHARDSON P.C.

21
22 By: /s/ David M. Hoffman
23 David M. Hoffman

24 Attorney for Defendant
25 NVIDIA CORPORATION

1 Dated: December 5, 2017

LAW OFFICE OF RYAN E. HATCH, PC

2

3

By: /s/ Ryan E. Hatch
Ryan E. Hatch

4

5

Attorney for Plaintiff
VISUAL EFFECT INNOVATIONS, LLC

6

7

Pursuant to Civ. Local Rule 5.1(i)(3) regarding signatures, I attest under penalty of perjury
that concurrence in the filing of this document has been obtained from counsel for NVIDIA.

8 Dated: December 5, 2017

LAW OFFICE OF RYAN E. HATCH, PC

9

10

By: /s/ Ryan E. Hatch
Ryan E. Hatch

11

12

Attorney for Plaintiff
VISUAL EFFECT INNOVATIONS, LLC

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28